REMARKS

This paper is submitted in reply to the Office Action dated December 5, 2007, within the three-month period for response. Reconsideration and allowance of all pending claims are respectfully requested.

In the subject Office Action, claims 38-62 and 65-75 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,029,180 to Murata et al.

Applicant respectfully traverses the Examiner's rejections to the extent that they are maintained. Applicant has amended claims 38, 50, 61 and 75 herein, and Applicant respectfully submits that no new matter is being added by the above amendments, as the amendments are fully supported in the specification, drawings and claims as originally filed. Applicant also notes that the amendments made herein are being made only for facilitating expeditious prosecution of the aforementioned claimed subject matter. Applicant is not conceding in this application that the originally claimed subject matter is not patentable over the art cited by the Examiner, and Applicant respectfully reserves the right to pursue this and other subject matter in one or more continuation and/or divisional patent applications

As an initial matter, Applicant notes that the current rejections are by Applicant's count the **seventh** separate rejection of the pending claims as they stand in their pre-amended form. Moreover, this rejection is now the third rejection issued subsequent to a complete reversal of the Examiner's prior rejections in a decision of the Board of Patent Appeals and Interferences. It is Applicant's understanding that MPEP §707(g) cautions against the use of piecemeal examination, and furthermore, MPEP §1214.04 notes that after a reversal "[t]he examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references." Applicant is of the belief that the course of prosecution of this Application is in direct contravention to both of these guidelines.

Now turning to the rejections, and in particular to the rejection of claim 1, this claim as rejected recited an apparatus that includes at least one processor; a memory

coupled to the at least one processor; and a computer program residing in the memory, said computer program commencing to download a file referencing a plurality of components, said computer program dynamically prompting a user to select which of said plurality of components to download.

As has been established by Applicant both as a result of a consistent usage throughout the prosecution history, and as a result of the Decision of the Board of Appeals, a "component" referenced by a file being downloaded does not correspond to hypertext links to other files that may be present in a particular file being downloaded.

Applicant defines "components" in the specification as "any item referenced in [an] HTML page to be downloaded and integrated with the page, such as graphics images, background images, audio, video and multimedia files, forms, applets, etc." (Application, page 7, lines 12-15, *emphasis added*). Based upon this definition, a hypertext link defined in a hypertext document, which references a different hypertext document that will be retrieved and displayed upon selection of the hypertext link, is not a "component' in the context of Applicant's invention.

This particular interpretation of the term "component" was accepted by the Board of Patent Appeals and Interferences in the Decision dated June 22, 2004. Specifically, the Board favorably cites page 2 of the Specification, which states:

> "Many web pages use extensive graphics and other "components" to dress up their web page, where components are defined in this patent to be any additional items referenced in HTML documents. These components are included in an HTML document through the use of specialized tags. For example . . . " (Decision, page 5, quoting Application, page 2).

Moreover, the Board indicates that the board considers "components" to be "items referenced in [an] HTML document." Id.

In rejecting claim 38, the Examiner now relies on Murata, and in particular Figs. 19 and 20A, col. 6, lines 19-67, col. 8, lines 19-48 and col. 15, lines 6-40. The latter passage on col. 15 is not relevant to Applicant's invention, however, as it is directed to the concept

of adding a home page to a "path" of home pages that a user wishes to create in order to view a collection of home pages in a particular sequence.

The remaining passages, in Figs. 19 and 20A and cols. 6 and 8, as well as other passages in the reference, disclose the use of a "summary file" that is either embedded in an HTML file or linked to by an HTML file, and is used to describe or summarize a different HTML file that is linked to by the HTML file within which the summary file is either embedded or linked. Essentially, the summary file describes another HTML file so that a user can determine whether they would like to download that HTML file before the file is ever downloaded. Thus, for example, an HTML file A may include a link to an HTML file B, as well as a summary file that enables a user to view summary information about HTML file B while HTML file A is being displayed. Based upon the summary information, the user can make a more informed decision as to whether he or she wishes to select the link to HTML file B and download that file.

It should be noted that, based upon the accepted construction of the concept of a "component" (a construction from which the Examiner is estopped from deviating by the Board Decision), whenever an HTML file is displayed in Murata, and summary information is presented about other HTML files linked to by the displayed HTML file, the other HTML files cannot be interpreted as "components" of the HTML file being displayed. Thus, any rejection of claim 38 that analogizes the other HTML files to "components" of the displayed HTML file in Murata cannot be sustained.

From the cited passage at col. 6 of Murata, it appears the Examiner may be attempting to analogize the separate HTML files, which are described by embedded summary information, to "components" of the displayed HTML file. As noted above, however, such a construction would be inconsistent with the accepted construction of a component, and as such, the rejection would be in error. In addition, it may be that the Examiner is considering the summary information itself to correspond to a "component." However, whether the summary information is embedded in the displayed HTML file, or provided in a separate HTML file, Applicant notes that the summary information is always downloaded with the original HTML file. Thus, there is no "dynamic prompting" that

occurs with respect to the summary information, and a rejection of claim 38 that relies on such a construction would likewise be in error.

On the other hand, col. 8 and Figs. 19 and 20A of Murata appear to disclose an embodiment where a pop-up window is displayed that enables a user to select the type of information should be retrieved for a linked-to HTML file. It appears from a reading of Murata that in this embodiment, whenever a user mouses over a link in a displayed HTML file, the type of the file is determined from the URL of that file (e.g., HTML or VRML), and based on this type, a popup window is displayed to enable a user to select a type of information to retrieve from that file. For an HTML file, for example, the user can select "text," "still image" or "all," resulting in the retrieval of only text, only images, or all of the data in the linked-to HTML file. It is somewhat unclear as to whether the information that is ultimately displayed is the linked-to HTML file or just summary information for that linked-to file; however, irrespective of this issue, in both scenarios, the user selects the type of data to be retrieved (be it summary information or the file itself) before information from the file is ever retrieved.

In particular, the type of information to query a user about is determined from the description of the file, i.e., the URL for the file as embedded in the displayed HTML file. Col. 8, lines 27-32 (which references steps S41-S43 in Fig. 19) states that "the information corresponding to the linked part is determined to be in an HTML or VRML format according to the description of the original file." Thus, what components are in a file is never determined in Murata, much less determined after at least a portion of that file has been retrieved. More importantly, the user is never prompted in this embodiment of Murata to select what information to download after information from the file has already been retrieved.

Claim 38, in contrast, recites in part "commencing to download a file referencing a plurality of components," and "dynamically prompting a user to select which of said plurality of components to download." In this regard, the concept of "dynamically prompting" is defined at page 12, lines 20-21 of the Application as originally filed, which states that "[I]n the preferred embodiment, the request to the web user occurs dynamically,

e.g., automatically after the HTML document is downloaded." Therefore, it is clear from the prosecution history that "dynamic prompting" requires that a user be prompted after some information from the HTML document has been retrieved.

To further clarify this temporal relationship between the commencement of downloading a file and dynamically prompting a user, claim 38 has been amended to clarify that "dynamically prompting" the user occurs "after commencing to download the file," support for which may be found in the aforementioned passage at page 12 of the Application as filed. Claim 38 therefore now makes explicit what was inherent in the claim, that a user is dynamically prompted as to which components referenced by a file should be downloaded after download of the file itself has already been commenced.

Applicant can find no embodiment in Murata that reads on this combination of features. In the only instance in which a user is prompted to select information to be downloaded in Murata, that prompt occurs prior to "commencement" of the download of any file within which that information might be stored or referenced. In the case of an HTML file, for example, col. 8 of Murata appears to disclose that the fact that the file is an HTML file is determined from that file's description, which appears to be the URL for that file (see, e.g., col. 13, lines 37-41 which notes that the "data format" for a file is determined from its file extension – ".html" for HTML files and ".wrl" for VRML files). The prompt to the user is based upon whether the file is HTML or VRML, and this prompt occurs prior to the retrieval of the file itself. It is only after the user selects the type of information that the file itself is downloaded. Step S47 of Fig. 19, in particular, discloses the retrieval of data from the file, and this occurs only after the user has selected the type of data in step S46.

Applicant therefore respectfully submits that Murata does not disclose the combination of "commencing to download a file referencing a plurality of components," and "dynamically prompting a user to select which of said plurality of components to download after commencing to download the file," as required by claim 38. Claim 38 is therefore novel over Murata, and the rejection should be withdrawn. In addition, the Examiner has presented no objective reason why one of ordinary skill in the art would be

motivated to modify Murata to incorporate Applicant's claimed combination of features. As such, no *prima facie* case of obviousness has been established for claim 38, and claim 38 is therefore patentable over the prior art of record. Reconsideration and allowance of claim 38, and of claims 39-49 which depend therefrom, are therefore respectfully requested.

Next, with respect to independent claims 50, 61 and 75, each of these claims has been amended in a similar manner to claim 38. Claim 50 has been amended to clarify that "prompting a user to select which of [a] plurality of components [referenced in a document] to download" occurs "after downloading of said document has commenced." Claims 61 and 75 have likewise been amended to clarify that "dynamically prompting a user to select which of [a] plurality of components to download" occurs "after commencing to download the file [within which the components are referenced]." As discussed above in connection with claim 38, Murata does not disclose or suggest the combination of commencing to download a file or document referencing a plurality of components, and dynamically prompting a user to select which of the components to download after commencing to download the file or document. Claims 50, 61 and 75 are therefore novel and non-obvious over Murata for the same reasons as discussed above for claim 38. Reconsideration and allowance of these claims, and of claims 51-60, 62 and 65-72 which depend therefrom, are therefore respectfully requested.

Next, with respect to independent claims 73 and 74, claim 73 recites in part a component download selection mechanism that "dynamically creat[es] a component download selection list when an HTML document with a plurality of components is downloaded," and that "prompt[s] a user to select which of said plurality of components to download." Likewise, claim 74 recites in part "requesting [an] HTML document from [a] web server," "parsing said HTML document for references to [a] plurality of embedded components," and "prompting a user to select which of said plurality of embedded components to download by displaying a component download selection list on [a] web browser." Therefore, in both claims, the dynamic prompting of the user occurs after at least a portion of the document that references the components has been retrieved or downloaded. Therefore, as with the other independent claims discussed above, Murata

falls short as an anticipatory reference, because Murata does not disclose any embodiment in which a user is prompted to select components from a file to download after downloading of the file itself has been commenced. Claims 73 and 74 are therefore novel over Murata, and the rejections thereof should be withdrawn. Reconsideration and allowance of claims 73 and 74 are therefore respectfully requested.

As a final matter, Applicant traverses the Examiner's rejections of the dependent claims based upon their dependency on the aforementioned independent claims. Nonetheless, Applicant does note that a number of these claims recite additional features that further distinguish these claims from the references cited by the Examiner. However, in the interest of prosecutorial economy, these claims will not be addressed separately herein.

In summary, Applicant respectfully submits that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

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Date

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